APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,737	12/08/2000	Cynthia Ann Adiano	RAL920000041US1	4788

7590 08/26/2005	EXAMINER
James Boice	WRIGHT, NORMAN M
Dillon & Yudell	
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Suite	2134
Austin, TX 78759	

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/733,737	ADIANO ET AL.
	Examiner	Art Unit	
	Norman M. Wright	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _02 May 2005_.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _46-75_ is/are pending in the application.

    4a) Of the above claim(s) _1-45_ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _46-75_ is/are rejected.

7) ☒ Claim(s) _53-57,60-63_ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

NORMAN M. WRIGHT
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-45 have been cancelled by an amendment filed 5/2/05.

Claim Objections

2.   Applicant is advised that should claims (47 and 53), (60 and 54), (55 and 61), (56-57 and 62-63), be found allowable, said claims will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 46-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 46-48, the claim recite, "permitting the software application to run...prevent the e-mail message ...from being forwarded..." As it is written it is unclear as to who or whom is permitting the software application from being run or forwarded. There does not appear to be recitation as to who or whom is making a determination or similarly processing the additional steps in claims 47-48.   Similar deficiencies are believed to exist in claims 52-57.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   As understood in view of the 112 problems recited above, claims 46-75 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Olkin et al., U.S. Pat. No.

6,584,564 and Leonard et al., U.S. Pat. No. 6,721,784, hereinafter respectively '564 and

784.

7.   As per claims 46, '564 teach a method for secure electronic distribution of

software media files (fig. 3 and col. 5, lines 42 et seq.) over networks comprising: e-mail

as a delivery mechanism (abs., figs. 2b, 3, 5, 6a, col. 3, lines 30-45 et seq., appending

as an attachment/file/media/data/program (col. 14, lines 36 et seq.), e-mail message,

opening, installing (figs. 3, 5, 8, col. 4, lines 17-25 et seq.), marking (fig. 6c) and storing

said files on a receiving/recipients computer (fig. 6a-b, col. 4, lines 35 et seq.). It does

not teach marking the e-mail as used to prevent further installations/desired events that

is being forwarded.

8.   '784 teach saving and marking media files to prevent disable further

installations/events and being forwarded (figs. 4 and 5 respectively (220 and 330), fig.

12 (20), figs. 13 and 15, abs., figs. 3-8, col. 6, lines 20-35 et seq., col. 19, lines 25 et

seq., and col. 20-21). '784 also use special handling instructions as part of the

installation process, failure to follow these instruction results in either nullification of the

installation process or termination/failure (col. 18, lines 16-40 et seq.). It would have

been obvious to one of ordinary skill in the art at the time of the invention to modify the

software distribution of '564, with a means of enabling and controlling the distribution of

an electronically transmitted message, an e-mail attachment, as disclosed by '784. One

of ordinary skill in the art would have been motivated to perform such a modification,

because, one of ordinary skill in the art would have realized that the originator of a e-

mail message might desire to control the distribution and viewing of the content of said

e-mail data as a way of safe guarding the data against unauthorized use and/or

distribution (col. 3, lines 50 et seq., and col. 6, lines 20 et seq., and col. 19-21). A

person of ordinary skill in the art, desiring not to have a user exceed his authority to use

or distribute an email and its data would have desire to implement a means of ensuring

that the user and system afforded some means of preventing a specific

event/installation from occurring, i.e. forwarding. A skilled artisan with such a desire in

mind would have viewed the invention of '784 as a means of adding access control and

security features to the e-mail system, while still making the data readily available. The

additional use and modification of the applets would have afforded the invention a

greater degree of control and security.

9.   As per claims 47, '564 teach permitting an application to run if it is from a pre-

specified e-mail server. '564 teach that a security server 24 and an e-mail server 22

work co-operatively, under the control of an applet program, with a sender to generate a

unique key and ID/data for an encrypted e-mail message. This key is utilized along with

a password to ensure registration and authentication of a receiving computer. The

receiving computer cannot run the program if it does not register with the security server

and thus the email server, thereby preventing execution if the key and ID data

determination data is missing. '784 similarly, teach using applets to control the

execution and delivery of e-mail messages and attachments (see col. 19, lines 47 et

seq., thru col. 21).

10.   As per claim 48, the discontinuation of installation if unsaved is not explicitly

taught. The examiner takes official notice of both the motive and modification

necessary to have an applet discontinue installation if an application is not saved

first/unsaved. It would have been obvious to one of ordinary skill in the art at the time of

the invention to further modify the invention of '564 and '784 to require that a computer

determine whether an application has been saved, before allowing it to be installed. A

person of ordinary skill in the art could have modified the java applet control program of

'564 and '784 to require that an e-mail attachment/program must be saved or else it is

preventing it from being installed. A person of ordinary skill in the art would have readily

envisaged that e-mail attachments may have become compromised, corrupted or been

exposed to a virus/worm. A person with such a desire in mind would have been

motivated to have the attachment/program saved before exposing their entire system to

its contents; moreover, if an attachment had become corrupted during the installation

process, then there would be no way of recovering the lost data without first

retransmission of the e-mail message. '564 provides for a myriad ways of installing e-

mail attachments see figs. 3, 5-8, col. 7, lines 55 thru, col. 8, lines 27 et seq.

11.   Alternatively, the e-mail attachments are routinely received and stored in the

inbox of a recipient's computer. System administrators conventionally require the

saving of executable objects to a safe space such as a protected zone or a computer

media before allowing installation on ones system. A person of ordinary skill in the art

would have readily envisaged that e-mail attachments may have become compromised,

corrupted or been exposed to a virus/worm. A person with such a desire in mind would

have been motivated to have the attachment/program saved before exposing their

entire system to its contents; moreover, if an attachment had become corrupted during

the installation process, then there would be no way of recovering the lost data without

first retransmission of the e-mail message. '564 provides for a myriad ways of installing

e-mail attachments see figs. 3,5-8, col. 7, lines 55 thru, col. 8, lines 27 et seq.

12.   As to claim 49, '564 allows imbedding instruction into the e-mail message,

encrypting a serial number/receiver data, decrypting, and comparing with a

registry/security server of authorized users/system. The security server and mail server

of '564 provides for a send secure feature. This feature requires that the receiving

computer first register for the secure servers in order to obtain secure e-mail and their

attachments. The applet then compares the information to verify the identity of the

recipient/receiving computer (figs. 7-8, col. 6, lines 12-col. 7, lines 25 et seq.).

13.   Alternatively, the encrypting of a serial number of the storage device in a registry,

'784 require that specific processes and events are followed as part of the installation

process, it does teach utilizing an encrypted form of the serial number as a part of

registering process for installation. It does, however, teach that the installation data

maybe stored either locally or remotely, see figs. 6, 9, and 16, and col. 16, lines 44 et

seq.. The examiner takes official notice of both the motive and modification necessary

for having a local processor store its identifying information/serial number/machine

identity in an encrypted registry as part of a validation/installation process.   '564 is

being recited as support for the taking of official notice, see fig. 5, col. 8, lines 40-45 et

seq., and lines 60-67 et seq., col. 10, line 25 et seq. It would have been obvious to one

of ordinary skill in the art at the time of the invention, to modify the installation and

verification processes of '784 with an applet subroutine as taught by '564, for enabling

the installation and verification process to having a registry that has identifying

information that is machine or computer specific and dependent. One of ordinary skill in

the art would have been motivated to perform this modification, because, one would

have had a desire to ensure, that after supplying a secured e-mail or application, that

the data or program was not inappropriately stored or used on a machine for which it

was not intended. A person of ordinary skill would have chosen this or any other well

proven method of protecting data as a means of providing additional steps in protecting

their data or program, as suggest by "784 at abs., col. 1, lines 20-45, col. 3, lines 50 et

seq., and col. 6, lines 20-34. '564 also indicates that the user may have various

installable options associated with an applet to permit registration, see '564 at col. 4,

lines 35 et seq., col. 6, lines, 13 et seq., and col. 8, lines 17-27 and 40-65 et seq.

14.   As to claims 50-51, the enabling of an authorized user identifier/password, and

installing only once, co-operatively the single use key, read only once install each use,

see '564 figs. 3, 6a-c, col. 7, lines 8 et seq., and col. 8, lines 15 et seq.

15.   As to claims 52-63 recite the concomitant elements of claims 46-51, accordingly

they are rejected under the same rationale. See above for the specifics of the

rejections.

16.   As per claims 64-69, they differ from rejected claims 46-64 by reciting a system

for carrying out the process steps of the method claims. '564 provides a system having

a means for appending, transmitting, receiving computer, permitting applications to run,

a specified e-mail server (collectively 22 and 24), means for embedding, receiving

encrypted, means for decryption, means for comparing, means for enabling/halting,

hardware/system with accompanying functions as recited above (fig. 1, sender,

receiver, e-mail server, security server, fig. 3, figs. 7-8 and col.5, lines 29 et seq.).

17.   As per claims 70-75, they differ from rejected claims 45-69, by reciting a

machine-readable medium having a plurality of instructions embodied therein. '564

teaches embodying his invention in the form of software modules see fig.4, and col. 5,

lines 40 et seq., col. 6, lines 12 et seq., col. 7, lines 54 et seq., col. 8, lines 15 et seq.

Conclusion

18.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

19.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norman Wright whose telephone number is (751) 272-3844. The examiner can normally be reached on Mondays - Thursdays from 9am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NORMAN M. WRIGHT
PRIMARY EXAMINER